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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,912	03/13/2002	Ove Ohman	3787-0112P	2980

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/070,912

Applicant(s)

OHMAN ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **RESPONSE TO AMENDMENT**

1. Claims 1-21 and 25-29 are pending in the application, claims 1-20 are withdrawn from consideration. Claims 22-24 have been cancelled.
2. Amendments to the claims, filed on February 6, 2004, February 10, 2004 and April 7, 2004, have been entered in the above-identified application.

### ***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. §112 rejections of claims 25-27, made of record in paper #8, mailed November 5, 2003, pages 4-5, paragraph #4 have been withdrawn due to Applicant's amendment in the responses filed February 6, 2004, February 10, 2004 and April 7, 2004.
4. The 35 U.S.C. §102 rejection of claims 21 and 25-27 over Furthey et al. (US Patent No. 5,840,407), made of record in paper #8, page 5, paragraph #7 have been withdrawn due to Applicant's amendment in the responses filed February 6, 2004, February 10, 2004 and April 7, 2004.
5. The 35 U.S.C. §102 rejection of claims 21, 25 and 26 over Hwang et al. (US Patent No. 4,902,553), made of record in paper #8, pages 5-6, paragraph #8 have been withdrawn due to Applicant's amendment in the responses filed February 6, 2004, February 10, 2004 and April 7, 2004.

***NEW REJECTIONS***

6. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 102***

7. Claims 21 and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Fry et al. (U.S. Patent No. 4,614,680).

Regarding Applicant's claim 21, Fry discloses a matrix (*decorative product, title*) comprising a microstructure on its surface (*embossed surface, col. 2, lines 57-66 and figure 3*).

As stated in the previous office action, the limitations referring the first and second master are referring the apparatus, which provides the matrix with a microstructured surface (see the specification page 12, line 6+). Furthermore, the apparatus used in the method of forming the product is not germane to the issue of patentability of the product itself unless the apparatus used in the process results in a patentably distinct structure. The limitation "the microstructure comprises microstructured surfaces of a first and a second master or of matrices produced therefrom, which surfaces are oriented adjacent each other" is anticipated by any matrix comprising a microstructured surface, which is the resulting structure. As can be seen in figure 2 in Fry the matrix has a microstructured surface (*embossed surface, col. 2, lines 57-66*).

The first and second masters or of the matrices, on their sides facing away from their microstructured surfaces, are covered by a first layer pertaining to the matrix (*filler material, col. 4, lines 32-36 and figure 3*). The first layer is covered by a carrier layer (*base layer, col. 3, line 5 and figure 3*).

The preamble “said matrix being suitable for placement as an insert in a mould cavity of a compression-moulding, embossing or injection moulding machine” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

Regarding Applicant’s claim 25, Fry discloses that the surface of the first master has been provided with a first microstructure, since the reference discloses that the embossment has different embossment textures (*col. 2, lines 26-40 and figure 1*).

Regarding Applicant’s claim 26, Fry discloses that the surface of the second master has been provided with a second microstructure, since the reference discloses that the embossment has different embossment textures (*col. 2, lines 26-40 and figure 1*).

Regarding Applicant’s claim 27, Fry discloses that the first and second surfaces have different structures, since the reference discloses that the embossment has different embossment textures (*col. 2, lines 26-40 and figure 1*).

Regarding Applicant’s claim 28, Fry discloses that the matrix further comprises a wear layer overlaying the first and second microstructured surfaces (*wear layer, col. 2, line 47 and figure 3*).

Regarding Applicant’s claim 29, Fry discloses that the wear layer is a plastic composite or metal, since the reference teaches that the wear layer is thermoplastic (*col. 2, line 47*).

8. Claims 21 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Furtney et al. (U.S. Patent No. 5,840,407).

Regarding Applicant's claim 21, Furthey discloses a matrix comprising a microstructure on its surface (*grooves, col. 4, line 6 and figure 7*).

As stated in the previous office action, the limitations referring the first and second master are referring the apparatus, which provides the matrix with a microstructured surface (see the specification page 12, line 6+). Furthermore, the apparatus used in the method of forming the product is not germane to the issue of patentability of the product itself unless the apparatus used in the process results in a patentably distinct structure. The limitation "the microstructure comprises microstructured surfaces of a first and a second master or of matrices produced therefrom, which surfaces are oriented adjacent each other" is anticipated by any matrix comprising a microstructured surface, which is the resulting structure. As can be seen in figure 7 in Furthey the matrix has a microstructured surface (*grooves, col. 4, line 6*).

The first and second masters or of the matrices, on their sides facing away from their microstructured surfaces, are covered by a first layer pertaining to the matrix (*optical films, col. 7, line 59 and figure 7*). The first layer is covered by a carrier layer (*adhesive or glass, col. 7, lines 64-65 and figure 7*).

The preamble "said matrix being suitable for placement as an insert in a mould cavity of a compression-moulding, embossing or injection moulding machine" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

Regarding Applicant's claim 25, Furthey discloses that the surface of the first master has been provided with a first microstructure (*figure 7*).

Regarding Applicant's claim 26, Furthey discloses that the surface of the second master has been provided with a second microstructure (*figure 7*).

Regarding Applicant's claim 27, Furthey discloses that the first and second surfaces have different structures (*figure 7*).

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

9. Applicant's arguments in the response filed April 8, 2004 regarding the 35 U.S.C. 112 and 102 rejections of record have been considered but are moot since the rejections have been withdrawn.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

7/19/04

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

7/19/04